

**ATTORNEY DOCKET NO.: 21101.0004U3
APPLICATION NO. 10/014,658**

Remarks

Claims 1-49 have previously been cancelled. New claims 144-187 were added. Claims 50-187 remain pending after entry of this amendment. Claims 50, 53, 56, 60, 63, 64, 65, 66, 67, 68, 69, 75, 78, 81, 85, 88, 89, 90, 91, 92, 98, 101, 104, 108, 111, 112, 113, 114, 115, 121, 124, 127, 131, 134, 135, 136, 137, and 138 have been amended herein, in accordance with the teleconferences of July 7, 2004, July 21, 2004, and July 23, 2004 with Examiner Schnizer.

Claims 50, 53, 56, 60, 63, 64, 65, 67, 68, 69, 75, 78, 81, 85, 88, 89, 90, 91, 92, 98, 101, 104, 108, 111, 112, 113, 114, 115, 121, 124, 127, 131, 134, 135, 136, 137, and 138 were amended to include the phrase “wherein the elastase-resistant ATIII is at least as resistant to elastase as plasma ATIII,” as discussed with Examiner Schnizer, so that it is clear that the words “Elastase resistant” do not mean that the claimed ATIIIs are limited to those that cannot be cleaved by elastase at all. This amendment does not narrow the claim, nor was it made for reasons related to patentability as the claims were clear and unambiguous as previously presented.

Claims 50, 53, 56, 60, 63, 64, 65, 67, 68, 69, 75, 78, 81, 85, 88, 89, 90, 91, 92 were also amended to include the words “at least about” which are also present in claims 98, 101, 104, 108, 111, 112, 113, 114, 115, 121, 124, 127, 131, 134, 135, 136, 137, and 138. As discussed with Examiner Schinzer, the Office Action dated April 7, 2004 indicated that claims 50, 53, 56, 60,

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63, 64, 65, 67, 68, 69, 75, 78, 81, 85, 88, 89, 90, 91, 92 were interpreted as having “at least” the stated activity even though these claims did not have the words “at least” present. Adding the words “at least about” was done merely to clarify the claims as they had been written before. As discussed with Examiner Schnizer the use of “about” is definite in this situation because of the presence of error bars used in Table 3. This amendment does not narrow the claim, nor was it made for reasons related to patentability as the claims were clear and unambiguous as previously presented.

Claims 112 and 134 were amended to remove a [].

Claims 65 and 66 were amended to indicate what was previously claimed which was that the specific residues of SEQ ID NO:35, 387-391, had a particular sequence set forth in either SEQ ID NO:4 or SEQ ID NO:5. Applicants maintain that the claims were clear and unambiguous as previously written and that the amendment did not narrow the claims nor was it needed for a reason of patentability.

New claims 144-185 can find support throughout the application, in particular in Table 3. These claims are either claiming a specific variant set forth in table 3 (claims 168-171, variant LEAI) or they are claiming variants related to P4 and P6. Furthermore, support for new claims 148, 149, 154, 155, 160, 161, 166, 167, and 172-187 dealing with specific glycosylation sites can be found at least at page 3, lines 7-21.

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Interview Summary

Applicant's Attorney and the Examiner discussed the case via teleconference on July 7, 2004, July 21, 2004, and July 23, 2004. Applicant greatly appreciates the efforts made by Examiner Schnizer in working with the Applicant toward resolution of the issues. During these interviews, the rejections set forth in the Office Action of April 7, 2004 were discussed. It was determined that the language "at least about" was not indefinite because there were error bars present in Table 3 which gave the word "about" meaning. Furthermore, it was determined that the language "wherein the elastase-resistant ATIII is at least as resistant to elastase as plasma ATIII," would be added to make it clear that "elastase-resistant" as used was not limited to ATIIIs which never could be cleaved by elastase. The applicant and the Examiner also discussed the filing of an Information Disclosure Statement with this Amendment.

Sequence listing

The Examiner previously requested during the prosecution of the parent application, U.S.S.N. 09/305,588, that the sequence disclosed in Bock et al., *Nuc. Acid. Res.* 10:8113-8125 (1982), be added to the specification. Applicants have complied with this request by adding it to the Sequence Listing as SEQ ID NO:35. SEQ ID NO:35 represents the sequence of ATIII disclosed in Bock et al. In connection with this addition and pursuant to MPEP § 608.01(p)I.A.2 applicants include within this Amendment a Declaration stating that the amendatory material consists of the same material incorporated by reference (see below).

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The Sequence Listing is amended so that it complies with the requirements of 37 CFR §§ 1.821 through 1.825. A new computer readable form and a paper copy of the Substitute Sequence Listing in full is provided on disk. The content of the paper copy and the computer readable form of the Sequence Listing are the same. No new matter is believed to be added by amendment of the Sequence Listing, as support for the additional sequences is found in Bock et al. and was well known to those of skill in the art at the time the application was filed.

Declaration Pursuant to MPEP § 608.01(p)I.A.2

Applicants declare that the sequence added to the specification, as requested by the Examiner, is believed to be the same sequence that is disclosed in Bock et al. This Declaration is made and attested to by the signature of the undersigned in their capacity as representative of the applicants.

Claim Objection

It is believed that claim 112 and 134 no longer have two periods, as they have been amended, mooting this objection. Removal of this objection is respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 65, 66 and 98-142 were rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite. As discussed in the interview, the claims 65 and 66 were clear definite as originally written, but have been amended, such that the claims have not been

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narrowed or amended for a reason related to patentability. Claims having the phrase “at least about” have not been amended, but determined to be definite as discussed in during the interview because there are error bars associated with the word “about.” This rejection is respectfully traversed and removal of this rejection is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

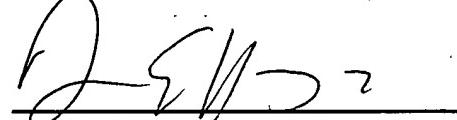
Claims 50-143 were rejected under 35 U.S.C. § 112, first paragraph for allegedly not being enabled by the specification. As discussed in the interviews, the claims have been amended by adding the phrase “wherein the elastase-resistant ATIII is at least as resistant to elastase as plasma ATIII,” which makes it clear that the phrase “elastase-resistant” is not limited to only those ATIIIs which are unable to be cleaved by elastase. This amendment does not narrow the claim as this amendment is broader than the Examiner’s previous understanding of “elastase resistant.” This rejection is respectfully traversed and removal of this rejection is respectfully requested.

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Authorization to charge Deposit Order Account No. 501977, \$903.00 representing the fee for the IDS (\$180.00), one month extension (\$55.00), and excess claim fees of \$668.00 are enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-145, on the date indicated below.

David E. Huizenga

Date August 9, 2004